

the surface thereof; and wherein said polyurethane film does not require the presence of any other anti-tack surface coatings or additives in order to exhibit such anti-tack properties.

18.(New) The anti-tack polyurethane film of Claim 17 wherein said antimicrobial is present within the interior of said film.

A3 19.(New) The anti-tack polyurethane film of Claim 18 wherein said antimicrobial compound is selected from the group consisting of elemental silver, silver-based ion exchange compounds, silver-based zeolites, silver-based glasses, and any mixtures thereof.

20.(New) The anti-tack polyurethane film of Claim 19 wherein said antimicrobial compound is selected from the group consisting of at least one silver-based ion-exchange compound.

REMARKS

Claims 1 and 4-20 are pending within the present application. Claims 2 and 3 have been canceled. Claims 1 and 4 have been amended. New Claims 17-20 have been added.

Support for the amendments to Claim 1 appear in previous claims 2 and 3. The amendment to Claim 4 has merely changed the dependency thereof. Claims 17-20 all find support in the claims as originally filed, as well as at the first four lines on page 8 of the originally filed specification. No new matter has been added with these amendment and thus entry and due consideration thereof by the Office are earnestly solicited.

The Office has rejected Claims 7-16 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Apparently, the Office has confused the use of the suffix -type with the word type in this situation. Applicants merely used the word type as a way to describe the test specimen for the cohesive (adhesive) property test of the subject claims. Such a test may be used with the same film specimen, or, alternatively, two different films of the same type. The word "type" thus is used only to indicate this alternative test subject which comprises the same polyurethane constituents, but free from the same antimicrobial silver-based compounds. As such the citation to Ex parte Copenheaver is misplaced. Reconsideration and withdrawal of such a rejection is thus respectfully requested.

The Office has rejected Claims 1-3 and 7-16 under 35 U.S.C. § 102(b) as being anticipated by Krall et al. Applicants respectfully disagree with this rejection in view of the amendments above since Krall et al. teach coated films only. These rejected claims now require the presence of the antimicrobial within the interior of the film as well as specific classes of silver-based antimicrobials not taught by patentees. Thus, Krall et al., does not teach any films with the same silver-based antimicrobial within their interiors (as presently claimed), and consequently does not anticipate the present claims. Reconsideration and withdrawal are thus earnestly solicited. Furthermore, there is nothing taught or fairly suggested within this reference even remotely discussing the anti-tack benefits accorded the target films through the presence of suitable antimicrobial agents as now claimed. As such, this reference fails to provide any anticipatory or obviousness bases of rejection over the new claims either.

The Office has also rejected Claims 1-15 under 35 U.S.C. § 102(b) as being anticipated by Capelli '151. Applicants respectfully disagree with such a rejection because Capelli requires an adhesive film, not an anti-tack film as now claimed. As such, Capelli not only fails to anticipate the current claims (both amended and new), but also follows a course completely divergent from that claimed by Applicants. Hence, citation of this reference over the pending claims is improper. Reconsideration and withdrawal of such a basis of rejection are therefore respectfully requested.

The Office has also rejected claims 4-6 under 35 U.S.C. § 103(a) as being unpatentable over Krall et al. in view of JP 09002537. Krall et al. is limited to a plastic coated with a film that comprises certain silver metal antimicrobials, but not the same as now broadly claimed in the currently rejected claims. The Japanese '537 reference (which is only an abstract) merely states that silver zirconium phosphate functions well within solid plastic articles. This is not disputed; however, Applicants have shown the unexpected anti-tack benefits of such specific silver-based antimicrobials, as well as other compounds within the silver-based list of the present claims. Although it is known that silver zirconium phosphate may provide color improvements within plastics, and such is taught within the Japanese '537 abstract, a second variable, anti-tack, is, again, a new and heretofore unknown and unexpected benefit from such a claimed class of antimicrobial silver-based compounds within such films. As such, it is evident that Applicants have provided suitable evidence of the patentability of this claimed invention. Furthermore, Krall et al. make no suggestion and thus provide no motivation whatsoever to replace their apparently excellent performing silver metal antimicrobials with any other types, more

importantly since Krall et al. specify that such silver metals work properly for films coating plastics, or in fibers, granules, or ribbons, but not in plastic articles as specifically taught within the Japanese '537 reference. Thus, it is improper to conclude and consequently improper to set forth that such a combination of references provides a proper prima facie basis of obviousness over the pending claims. Again, the Japanese '537 reference discloses silver zirconium phosphate is proper for plastic articles (housing containers for receiving foods or as tableware, in particular) and provides no suggestion that such an additive is a proper replacement for silver metals as an antimicrobial additive within plastic coatings, such as films, ribbons, granules, or fibers, as taught by Krall et al. Additionally, such a replacement of seemingly proper functioning silver metals by silver zirconium phosphate is again, unexpectedly good, as determined by Applicants' own work, particularly in terms of color and anti-tack benefits. As such, it is respectfully submitted that not only is a proper prima facie obviousness rejection lacking in this situation, but the combination as set forth is evidently an improper exercise of hindsight reconstruction of Applicants' own teachings. Reconsideration and withdrawal of such an improper basis of rejection are therefore earnestly solicited.

The Office has also rejected claims 1-16 under 35 U.S.C. § 103(a) as being unpatentable over JP 11028797 in view of JP 09002537. Applicants again traverse the basis of such a rejection for much of the same reasons as the rejection immediately preceding. Specifically, the primary abstract (the Japanese '797 reference) fails to mention what type of antimicrobial, if any, is present within the film portion of the film/resin mold system (used ultimately to form a hardened polyurethane article, apparently, from a resin of elongation between 300-1000%).

There is no discussion of the unique, unexpected properties Applicants discovered involving the specific silver-based antimicrobials as now claimed. Nor are there any disclosures of the importance or possible replacement of the '797 reference's antimicrobial with silver zirconium phosphate at all. Again, Applicants have shown the importance of utilizing specific silver-based antimicrobials to provide low color, excellent anti-tack benefits within target polyurethane films. Thus, as above, there is no proper prima facie obviousness rejection provided, or, alternatively, if one is proffered by the Office, the secondary consideration of the unexpected benefits accorded such films through the presence of such antimicrobials is sufficient to overcome such obviousness. Otherwise, there would clearly be an impermissible hindsight reconstruction of Applicants' claimed invention by the Office. Reconsideration and withdrawal of such an improper rejection are thus respectfully requested.

CONCLUSION

In view of all of the previous remarks, it is respectfully submitted that the pending claims are now in condition for allowance and it is requested that this application be passed on to issue.

Respectfully submitted,

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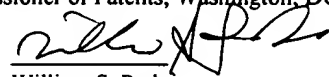
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Box Non-Fee Amendment, Commissioner of Patents, Washington, DC 20231, on May 13, 2002, along with a postcard receipt.



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MARKED-UP VERSION OF AMENDMENTS TO 09/851,042

1.(Amended) A polyurethane film comprising a silver-based inorganic antimicrobial compound in discrete areas of said film wherein at least some of said antimicrobial compound is present at the surface of said film and[,optionally,] at least some of said antimicrobial is present within the interior of said film; wherein said antimicrobial compound is selected from the group consisting of elemental silver, silver-based ion exchange compounds, silver-based zeolites, silver-based glasses, and any mixtures thereof.

4.(Amended) The polyurethane film of Claim [3] 1 wherein said antimicrobial compound is selected from the group consisting of at least one silver-based ion-exchange compound.